

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alain LEAS et al.	Confirmation No.: 4476
Application No.: 10/797,373	Group Art Unit: 1794
Filing Date: March 9, 2004	Examiner: Viren A. Thakur
For: PACKAGED DECORATED FROZEN CONFECTION AND METHOD OF MANUFACTURE	Attorney Docket No.: 88265-74701

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
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Sir:

In response to the Examiner's Answer mailed on March 5, 2009, Appellant respectfully submits this Reply Brief and requests that this Reply Brief be considered and made of record in this application. Appellant generally includes herein only the sections required under 37 C.F.R. § 41.41 and the Manual of Patent Examining Procedure § 1208, since the remaining information is provided in the Appeal Brief filed January 29, 2007. The pending claims on appeal, although unchanged from the Appeal Brief, are attached as Appendix A for the Board's convenience.

Also submitted herewith is a Request for Oral Hearing under 37 C.F.R. § 1.17(d), with fee authorization. A fee of \$ 540.00 is estimated to be due for the submission of this Reply Brief. Please charge any and all required fees for processing these documents to Winston & Strawn LLP Deposit Account No. 50-1814.

1. STATUS OF CLAIMS (POST APPEAL BRIEF)

Applicant submitted an Appeal Brief appealing the rejection of claims 1-4, 8-10 and 25-37 on January 13, 2009. The Examiner submitted an Examiner's Answer on March 5, 2009. In the Examiner's Answer, the Examiner maintained the rejection of claims 1-4, 8-10 and 25-37 on the above identified grounds with the following two exceptions.

First, the Examiner withdrew the obviousness-type double patenting rejections of: claims 1-4, 8-10, 25-30, 32-36 in view of the abandonment of previously co-pending Application No. 10/294,764, now abandoned, which the double patenting rejection had relied on; claims 1-4, 8-10, 25-33 in view of the abandonment of previously co-pending Application No. 10/385,177, now abandoned, which the double patenting rejection had relied on; claims 1-4, 8-10, 25-31 in view of the abandonment of previously co-pending Application No. 10/800,222, now abandoned, which the double patenting rejection had relied on.

Second, the Examiner withdrew the obviousness-type double patenting rejection of claims 1-4, 8-10 and 25-30 over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of the cancellation of claims 1-3 and 7-14 in Application No. 10/984,914.

The Answer restated the positions that had been previously taken with the following new arguments in response to Appellant's arguments. In response to Appellant's argument that there needs to be motivation found in the art to make the combination in the manner alleged, the Examiner additionally took the position that "the motivation to combine the references need not lie in the primary reference" while simultaneously combining the Krein, D'Amato and Kuehl references in a manner which the Appellant believes do not constitute the claimed invention. The Examiner also stated a new argument that the motivation for packaging material (such as a paper wrapper) in Krein was possibly other than to provide the Krein stated "economical material." In response to Appellant's position in its Appeal Brief that D'Amato also appears to teach advertising on the transparent material itself, the Examiner disagreed noting that "Figure 3 of D'Amato show the transparent packaging and the written words shown in the figure (item 15) are inside the transparent packaging (11)." The Examiner's new argument in response to Appellant's position that "D'Amato's ice confection is prepared outside the packaging" and that there "also would not be a smooth exterior surface of the shell, since there is no disclosure in D'Amato as to how to form such a smooth surface cone" stated that "appellants' claims are directed to the product and as such, the patentability of a product, as claimed, cannot be

predicated on the particular method by which the product was made.” The Examiner further argued that Kuehl was used for the purpose of providing a particular appearance on a fat-based confection shell while employing more than one fat based composition, without disagreeing that Kuehl neither disclosed a packaging sleeve for wrapping the bars, nor disclosed a complete surface-to-surface contact with the transparent packaging sleeve. The Examiner also took the position that “[i]n view of the art art taken as a whole, the reason for providing the transparent packaging is to allow the consumer to view the product, instead of a printed image depicting the product.” The Examiner argued instead that Appellant’s focus on the particular methods employed by the Newsteder, Palmer and Phillips references was not supported by any convincing evidence, that the claims were directed to a product and as such, to modify the product and change the design to take the shape of writing, symbols or logos would still have been an obvious matter of choice and/or design. The Answer’s new argumentation is addressed below.

2. ARGUMENT ADDRESSING NEW ISSUES RAISED IN EXAMINER'S ANSWER

Appellant incorporates by reference its arguments from its Appeal Brief. Appellant respectfully submits that Krein, D’Amato, Kuehl, Newsteder, Palmer and Phillips do not support the claim rejections and provides the following additional information and explanation to address the Examiner’s new issues and comments.

a) Obviousness and Motivation to Combine References

Applicant respectfully submits that the Examiner improperly interpreted the most recent law on obviousness and on motivation to combine references as it pertains to the facts of the present case.

The Examiner erroneously stated the following reasons to establish motivation to combine Krein, D’Amato and Kuehl. First, based on his select citations of the cited references, the Examiner did not correctly address the issue that the references need to be combined in the manner alleged in the invention, and mischaracterized Appellant’s claims instead. According to the Examiner, even though Krein does not contain transparent packaging, it would be inherent that the Krein invention has a smooth surface and that it has a “highly attractive” confection with two tone color effect. (Examiner’s Answer at 11-12.) Further per the Examiner, D’Amato teaches transparent packaging for an ice cream confection. (Examiner’s Answer at 12, 17.) This

lead the Examiner to conclude that “the combination of Krein and D’Amato teaches the actual use of transparent packaging for viewing the actual ice cream confection, and that the “claim still differs from this combination in reciting a decorative pattern design comprising strings of a first semi-solid confection material that forms a mesh of springs a second confection of contrasting color to that of the first confection.” (*Id.*) Lastly, the Examiner relied on Kuehl for its alleged teaching of a fat based composition of a hardened shell, which provides a decorative pattern of two confection materials with “marbled appearance.” (*Id.*) This characterization by the Examiner of Appellant’s claims and of the alleged applicability of prior art to them is in apparent mischaracterization of Appellant’s claims.

The present invention recites that (1) the decorative pattern design forms a smooth surface of the outer wall of the shell on a frozen confection product, (2) the entire packaging sleeve is transparent, and (3) the entire outer surface is in contact with the packaging sleeve. Thus, the Examiner completely omitted the motivation to achieve a decorative design (such as a writing or a logo) on a transparent surface with complete surface-to-surface contact with the packaging sleeve. Thus, the Examiner did not establish any motivation to combine Krein, D’Amato and Kuehl so as to achieve to an internal, smooth decorative design on a frozen confectionary with a formative, complete contact-to-contact transparent wall, which is also simultaneously a protective sheet and a container.

The U.S. Supreme Court recently addressed the issue of obviousness in *KSR Intl v. Teleflex Inc.*, No. 04-1350, 127 S.Ct. 1727 (April 30, 2007), stating that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.” *Id.* at 1741. The Court instructed that obviousness may be proved by showing that the combination of elements was “obvious to try”, which arises, according to the Court:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, *predictable solutions*, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. *If this leads to the anticipated success*, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

Id. at 1740. (emphasis added)

None of the cited references by the Examiner establish that this particular combination of the present invention constituted either a design need to solve a problem, or that it was an obvious to try and a predictable solution to decoratively designing a frozen confectionary simultaneously on a transparent surface and on the confectionary itself, while also forming and protecting the frozen confectionary. It is completely erroneous for the Examiner to disagree with the proper analysis in *KSR*, while disregarding features of the present invention in stating that “[i]n view of the art art taken as a whole, the reason for providing the transparent packaging is to allow the consumer to view the product, instead of a printed image depicting the product.” (Examiner’s Answer at 25.) Likewise, under the analysis in *KSR* the Examiner is wrong to disagree that the outer surface of the shell in the contact with the sleeve provides unexpected results. (Examiner’s Answer at 16.) Under the Supreme Court analysis in *KSR*, the very texture and physico-chemical characteristics of frozen confectionary and its methods of preparation and preservation would not have led a person of skill in the art to find such a claimed combination predictable or to conclude that the combination in the present invention resulting in anticipated success in the claimed manner.

There being no suggestion to combine the disclosures or teachings of the references as advanced by the Examiner except by using Applicants’ invention as a template through a hindsight reconstruction, the rejection is improper. *See Ex Parte Crawford*, Board Appeal Decision 20062429 (Decided May 30, 2007). The Examiner’s continued arguments have still not provided a sufficient reason of why the disclosures of the references should be combined. *See Ex Parte Erkey*, Board Appeal Decision 20071375, (Decided May 11, 2007). There is no evidence or suggestion in the secondary references D’Amato and Kuehl that designs can be achieved on a frozen confectionary while being formed, protected, displayed transparently, placed in complete smooth contact with the confectionary, and enclosed in a protective sheet- all simultaneously. *See Ex Parte Katoh*, Board Appeal Decision 20071460 (Decided May 29, 2007); *see also Ex Parte Owlett*, Board Appeal Decision 20070644 (Decided June 20, 2007).

b) Advertising by D’Amato

The Appellant also took the position in its Appeal Brief that D’Amato appears to teach advertising on the transparent material itself. The Examiner disagreed noting that “Figure 3 of D’Amato show the transparent packaging and the written words shown in the figure (item 15) are inside the transparent packaging (11).” (Examiner’s Answer at 15.)

Appellant respectfully disagrees with the Examiner's characterization. The writing in question in D'Amato appears to be either on the container itself, or on a paper or a paper-like material on top of the frozen confectionary, or stamped onto a wafer on the frozen confectionary, but not a part of a fat-based layer of the frozen confectionary texture itself. The Examiner's analysis is further erroneous given the fact that the Examiner did not disagree that D'Amato prefers to place his ice confections in cardboard sleeves which contain advertisements, labels or pictures, which may be viewable through the plastic container and relying on the advertising rather than the product itself. (Examiner's Answer at 17, 23.)

c) D'Amato, Krein, Kuehl, Newsteder, Palmer and Phillips Are Not Analogous Prior Art for Appellant's Invention

In response to Appellant's position that "D'Amato's ice confection is prepared outside the packaging" and that there "also would not be a smooth exterior surface of the shell, since there is no disclosure in D'Amato as to how to form such a smooth surface cone" the Examiner also argued that "appellants' claims are directed to the product and as such, the patentability of a product, as claimed, cannot be predicated on the particular method by which the product was made" and further admitted that "D'Amato has not been relied on to teach complete surface to surface contact or a smooth exterior surface of the shell", but "rather has been relied on to teach the advantages of providing transparent packaging for an ice confection." (Examiner's Answer at 15-16, 29.) The Appellant respectfully disagrees with the Examiner. The present invention clearly recites the packaging sleeve as a part of the product itself, and clearly provides that with the packaging sleeve is formed in a shape that corresponds to the desired shape of the outer surface of the shell, that the entire packaging sleeve is transparent, and that the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve. (*See, e.g.* Claim 1.)

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). MPEP 2143.01. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavour or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). MPEP 2141.01(a). *See*

also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavour, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavour, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

Therefore, the Appellant’s argument clearly refers to an explicit and necessary characteristic of the claimed frozen confectionary product itself, whereas the Examiner’s argument only refers to a completely separate product from that of the frozen confectionary- a transparent container, which is not reasonably pertinent to the particular problem with which the invention was concerned- namely, the problem of using a sleeve for packaging, for a wall providing a desired corresponding shape, for transparency and for a complete surface-to-surface contact, all achieved on the product simultaneously. As such, D’Amato may not be considered analogous art, as the subject matter disclosed therein is not relevant to the particular problem with which the inventor is involved, and for which D’Amato does not provide any reasonable know how for anticipated success.

Regarding the Examiner’s argument that the motivation for packaging material (such as a paper wrapper) in Krein was other than to provide the Krein stated “economical material”, Appellant respectfully urges that this argument also fails. (Examiner’s Answer at 13-14.) While it is perhaps advantageous that Krein’s food product have an appealing look, Krein’s packaging motivation was clearly not in the combination of the packaging revealing the appealing look of a specifically designed and in a complete contact transparent frozen confectionary product, nor was it in providing a shell for arriving at a specific shape while maintaining the necessary rigidity for achieving the frozen confectionary design. The Examiner cannot in hindsight modify the teachings and suggestions of Krein of an economical packaging material, so as to arrive at the packaging design appeal and utility of the presently claimed invention. (Examiner’s Answer at 20-22.) While himself pointing out that the Krein invention was made approximately about 66

years before Appellant's invention, the Examiner did not point to any disclosure, which under *KSR* would have led to the conclusion that the combination of the present invention would have led to anticipated success at the time of Krein's invention. (Examiner's Answer at 22-25.)

The Examiner further argued that Kuehl was used for the purpose of providing a particular appearance on a fat-based confection shell while employing more than one fat based composition, without disagreeing that Kuehl neither disclosed a packaging sleeve for wrapping the bars, nor disclosed a complete surface-to-surface contact with the transparent packaging sleeve. (Examiner's Answer at 18-20.) In so doing, the Examiner completely disregarded the opinion to the contrary of the person of skill in the art, which pointed out that unlike the present invention, Kuehl was concerned with imparting an attractive appearance to its chocolate bars of different patterns, shapes or colors, where the smooth appearance of the Kuehl products was only incidental to the additional step of placing the products in a mold. (Declaration of Alain Leas Under 37 C.F.R. § 1.132, ¶ 15.) In contrast, the present invention is made in a much less complicated manner, with the strings being provided to conform to and be in contact with a packaging sleeve of similar dimensions during formation of the shell so that a smooth outer surface is automatically achieved during formation of the product. (*Id.*) Even disclosure in Kuehl, which teaches a container that closely follows the volume and contour of the pre-fabricated confectionary clearly teaches a different invention. (Examiner's Answer at 19-20.) It is accordingly improper to only take Kuehl for one aspect of its teachings, while disregarding all other aspects of it, which clearly teach away from the present invention.

To the extent that the Examiner has further disagreed with the Appellant's argument that Newsteder, Palmer and Phillips all disclose methods by which to impart designs or lettering onto food, none of the references disclose or suggest that the methods disclosed therein would even be suitable for imparting design or letter shells in ice confectionaries. The Examiner argued instead that Appellant's focus on the particular methods employed by the Newsteder, Palmer and Phillips references was not supported by any convincing evidence, that the claims were directed to a product and as such, to modify the product and change the design to take the shape of writing, symbols or logos would still have been an obvious matter of choice and/or design. (Examiner's Answer at 29-30). The Examiner has failed to show any methods whatsoever that were "obvious to try" in order to arrive at the claimed product. Yet again, the Examiner has improperly deconstructed the present invention in hindsight, only cherry picking features from

the references that only the Examiner seems fit, largely arrived at by methods that are clearly inapplicable to the present invention and thus not reasonably pertinent to the particular problem with which the inventor was concerned, to arrive at a product that is clearly not shown by the Examiner on reconstruction to be of any anticipated success by the combining of the alleged references.

In view of the preceding discussion, Appellant maintains that the rejections of claims 1-4, 8-10 and 25-37 are in error, and respectfully requests that these rejections be reversed and that these claims be allowed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Allan A. Fanucci", written over a horizontal line.

Allan A. Fanucci

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May 1, 2009
Date

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